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REMARKS

The undersigned attorney thanks Examiner Blau for his careful review of this patent application. Reconsideration of the preset application is respectfully requested in light of the above amendments to the claims in view of the following remarks. Prior to entry of this amendment, claims 18 - 27 were pending in the application. Claims 18, 24, and 25 has been amended. Claims 21, 22, and 27 have been canceled. New claim 28 has been added. Upon entry of this amendment, claims 18 - 20, 23 - 26, and 28 will be pending in the application.

Drawings

Figure 1 has been amended to remove reference numbers 16a, 16b, and H2. An annotated marked-up copy along with a replacement sheet is being submitted.

The Claims Are in Compliance with 35 U.S.C. §112

Claims 18 and 24 have been amended to more particularly point out and distinctly claim the invention. Claims 25 and 26 now properly depend upon claim 24 in light of the amendments to claim 24. Claims 21, 22, and 27 have been canceled.

It is respectfully requested that the rejection of the claims be withdrawn.

Claim 24-25 Are Not Anticipated by Schmidt

In paragraph 3, the Office Action rejected Claims 24-25 as being anticipated by U.S. Patent No. 5,330,187 to Schmidt (hereinafter "*Schmidt*").

Schmidt describes a cavity-back iron golf club that has two intersecting recess projecting to the rear proximate to the periphery of the face portion to define a front wall. The two recesses include a forwardly and rearwardly extending main recess and an undercut recess located directly rearwardly of the front wall and extending laterally outward from the forward most extent of the main recess toward *at least two areas*, including the top wall, the bottom wall or sole, the toe region, and the heel region. Typically, the undercut recess portions associated with the walls are elongated directionally between the toe and heel portions, over the major length of the iron golf club head. This redistributes metal toward *both the upper and lower* peripheries of the head and projecting rearwardly to enhance the anti-twist of the golf club. The undercuts on both the

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top and bottom periphery are believed to achieve a delayed momentum transfer from the wall portions to the front wall and face.

The invention of amended Claim 24 describes an iron golf club head that contains a single cavity portion, a toe portion to a heel portion, a face portion, and a sole portion. The golf club head has only one projected wall portion that is offset from said face portion that has a length along the first axis that is less than the length of the cavity.

To anticipate a claim, the reference must teach each and every element of the claim. MPEP § 2131. *Schmidt* fails to disclose a golf club head having a cavity portion and has only one projected wall portion offset from the face portion having a length along an axis extending from the heel of the golf club to the toe of the golf club that is less than the cavity portion. The golf club described by *Schmidt* requires a main recess and an undercut recess. The undercut recesses must extend laterally outwardly from the forward most extent of the main recess toward at least two regions, thereby forming at least two extended wall projections.

In contrast, the iron golf club head of amended claim 24 has only one projected wall portion. Therefore, each and every element of amended claim 18 is not described, taught, or suggested by the cited references either separately or in combination.

Because *Schmidt* does not describe, teach, or suggest a cavity back golf club head iron head that consists of a single projected wall portion offset from the face portion having a length along an axis extending from the heel of the golf club to the toe of the golf club that is less than the cavity portion, claim 24 is patentable over the cited reference. Therefore, it is respectfully requested that the rejection of Claim 24 be withdrawn.

The foregoing argument applies to Claims 25, which depend upon claim 24 and is also patentable over the cited reference. It is respectfully requested that the rejection of claim 25 be withdrawn.

Claims 18, 19, 20, and 26 Are Not Rendered Obvious in View of *Schmidt* and *Kosmatka*

In paragraphs 9 and 10, the Office Action rejected claims 18 – 22, and 26 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. *Schmidt* in view of Great Britain published patent application No. 2,331,249 to Kosmatka (herein "*Kosmatka*").

Kosmatka describes an iron golf club head that has a contoured back surface that has varying thicknesses such that the regions of the face that are expected to experience the highest

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levels of internal loads are thickest, while those areas that are expected to experience the lowest levels of internal loads are thinnest. The contoured back surface contains a number of regions of varying thicknesses such that the club face generally thins out at the face/top wall intersection region approaching the toe and the face/top wall intersection region approaching the heel. In general the contoured regions follow along a vertical stiffening region and a horizontal stiffening region, which approximate an upside down "T" such that the cross bar of the "T" lies along the face/bottom wall intersection region and the upright leg of the "T" lies along the central vertical axis.

The invention of amended Claim 18 describes an iron golf club head that contains a single cavity portion, a toe portion to a heel portion, a face portion, a back portion, and a sole portion. The sole portion contains a groove that extends along the face portion on a surface in the cavity portion. The face portion contains a ball hitting portion that has a thickness that is greater than the thickness of a top edge side portion of the face portion that is located between the ball hitting portion and the top edge portion of the golf club. Additionally, the ball hitting portion is at least as thick as a thickness of a sole side portion of the face portion that is located between the ball hitting portion and the sole portion that extends along the groove. The golf club head also has only one projected wall portion that is offset from said face portion that has a length along the first axis that is less than the length of the cavity. The projected wall portion has an inner surface that is defined by the groove and an outer surface that is flush with the back portion of the iron golf club.

Each and every element of the claimed invention, and well as a motivation or suggestion to combine the elements, must be found in the references to establish a *prima facie* case of obviousness. MPEP §2142. Neither *Schmidt* nor *Kosmarka* describe, teach, or suggest an iron golf club head that has only one projected wall portion offset from said face portion that has a outer surface that is flush with the back portion of the iron golf club. Although the golf club described by *Schmidt* fails to disclose a golf club head having a cavity portion and has only one projected wall portion offset from the face portion having a length along an axis extending from the heel of the golf club to the toe of the golf club that is less than the cavity portion.

Because none of the references describe, teach, or suggest either singularly or in combination, a cavity back golf club head iron head that has only one projected wall portion offset from the face portion having a length along an axis extending from the heel of the golf

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club to the toe that is less than the cavity portion along the same axis and has a outer surface that is flush with the back portion of the iron golf club, amended claim 18 is patentable over the cited references. Therefore, it is respectfully requested that the rejection of claim 18 be withdrawn.

The foregoing arguments apply to claims 19, 20, and 26 which depend upon claim 18 and are also patentable over the cited references. It is respectfully requested that the rejection of these claims be withdrawn.

Claims 18, 19, 20, and 26 Are Not Rendered Obvious in View of Stites and Kosmatka

In paragraph 12, the Office Action rejected claims 18 – 21 and 26 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,695,937 to Stites (hereinafter “*Stites*”) in view of Great Britain published patent application No. 2,331,249 to Kosmatka (herein “*Kosmatka*”).

Stites describes a golf club head that has a heel portion, a toe portion, a bottom sole portion, a top ridge portion, a striking face, a rear surface, and a peripheral mass on the rear surface, which forms a rear cavity. The golf club head also contains a cantilevered mass that extends from the bottom of the sole portion toward the top ridge portion within the rear cavity. *Stites* further describes that the cantilevered mass may be disposed in one of three positions along the bottom of the sole portion between the heel portion and the toe portion. The cantilevered mass may be progressively moved from the low heel area for long irons, to a middle position for middle irons, to a higher position toward the toe for short irons.

The invention of amended claim 18 describes an iron golf club head that contains a single cavity portion, a toe portion to a heel portion, a face portion, a back portion, and a sole portion. The sole portion contains a groove that extends along the face portion on a surface in the cavity portion. The face portion contains a ball hitting portion that has a thickness that is greater than the thickness of a top edge side portion of the face portion that is located between the ball hitting portion and the top edge portion of the golf club. Additionally, the ball hitting portion is at least as thick as a thickness of a sole side portion of the face portion that is located between the ball hitting portion and the sole portion that extends along the groove. The golf club head also has only one projected wall portion that is offset from said face portion that has a length along the first axis that is less than the length of the cavity. The projected wall portion has an inner surface

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that is defined by the groove and an outer surface that is flush with the back portion of the iron golf club.

Each and every element of the claimed invention, and well as a motivation or suggestion to combine the elements, must be found in the references to establish a *prima facie* case of obviousness. MPEP §2142. Neither *Srites* nor *Kosmatka* describe, teach, or suggest an iron golf club head that has only one projected wall portion offset from said face portion that has a outer surface that is flush with the back portion of the iron golf club. Although the golf club described by *Srites* contains a cantilevered mass that is spaced apart from the rear surface, the cantilevered mass described by *Srites* is contained entirely within the rear cavity. (Col. 3, lines 62 – 64; FIG. 3). In fact, *Srites* teaches that the outer surface of the cantilevered mass is inset from the peripheral mass that forms the rear cavity, as shown by FIG. 3 and therefore is not flush with the back portion of the golf club.

The golf club of amended claim 18 on the other hand, requires that the outer surface of the only one projected wall portion is flush with the back portion of the golf club. Therefore, because none of the references describe, teach, or suggest a cavity back golf club head iron head that has only one projected wall portion offset from the face portion having a length along an axis extending from the heel of the golf club to the toe of the golf club that is less than the cavity portion along the same axis and has a outer surface that is flush with the back portion of the iron golf club, amended claim 18 is patentable over the cited references. Therefore, it is respectfully requested that the rejection of claim 18 be withdrawn.

The foregoing arguments apply to claims 19, 20, and 26 which depend upon claim 18 and are also patentable over the cited references. It is respectfully requested that the rejection of these claims be withdrawn.

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New Claim 28 Is Fully Supported by the Specification

The present application has been amended by adding claim 28. It is respectfully submitted that the subject matter recited by this new claim is fully supported by the specification in the present application. It is further submitted that the new claim is patentable over the references of record, and allowance of these claims is petitioned.

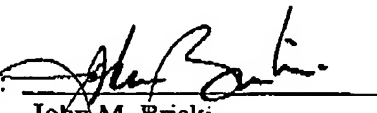
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CONCLUSION

It is respectfully submitted that claims 18 – 20, 23 – 26, and 28 are in condition for allowance and that each point raised in the Official Action with regard to these claims has been fully addressed. Therefore, it is respectfully requested that the rejections of the claims be withdrawn and that claims 18 – 20, 23 – 26, and 28 be processed to issuance in accordance with Parent Office Business.

If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any informalities that can be corrected by an Examiner's amendment, please contact John Briski at 404.885.3141.

Respectfully submitted,

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